

REMARKS

In view of the above amendments and discussions to follow, Claims 12-23 which are in the application avoid or overcome the rejections which are as follows. Claims 14-19 & 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Karlou Eyrisch et al (US 2002/0106659 A1). Claims 12-23 are rejected under 35 U.S.C 103(a) as being unpatentable over Bonn et al (WO 94/11305 May 26, 1994) in view of Noetzel et al (US 4,568,706 February 4, 1986).

Claims 14-16, 18, and 23 are rejected as being indefinite because the acronym "BET" is confusing. The rejection has been overcome per the Examiner's suggestion by amending the claims to recite Brunauer-Emmett-Teller.

Claims 14-15, 17, 19 & 23 stand rejected as being indefinite because the phrase "swell in water" or "swellable in water" is confusing. Applicants traverse the rejection because the term "swell in water" as to scope and content is readily ascertainable by the skilled artisan.

Claims 14 and 23 stand rejected as being indefinite because the term "hydrophilic" is confusing. While Applicants appreciate the Examiner's recommendation for amending the claims, they respectfully submit that given that the term hydrophilic is well known in the art, it is unnecessary to amend the same.

Claims 12-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Karlou Eyrisch et al (US 2002/0106659 A1). Karlou-Eyrisch et al teach a bead polymer and a method for isolating nucleic acids from a sample containing nucleic acid. Applicants traverse the rejection because Karlou-Eyrisch et al differ from the claims in that it in

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contrast teaches crosslinked beads doped with superparamagnetic iron oxide. As such Karlou-Eyrisch et al does not anticipate the claims.

Claims 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonn et al (WO 94/11305 May 26, 1994) in view of Noetzel et al (US 4,568,706 February 4, 1986). While acknowledging that Bonn et al differ from the claims in failing to teach pore diameter of from 10 to 1000nm, the Examiner contends that the failing of Bonn is cured by Noetzel macroporous bead polymers and a method for preparing and using the same where the pore diameter is 10 to 1,000 nm (col. 5, lines 53-67).

Unfortunately, the office action is silent as to what would have motivated one of ordinary skill at the time the invention was made to apply Noetzel et al's pore diameter of 10 to 1,000 nm to Bonn et al's **non-porous** bead polymer to arrive at the claims of the invention.

Contrary to the assertion of record, there is no basis for the statement that an ordinary practitioner would have recognized that the pore diameter as a result-optimizable variable as held in *In re Aller*, 105 USPQ 233 at 235.

In this regard, it would be helpful in advancing the prosecution, for the Examiner to point out why the pore diameter would have been considered a result-variable.

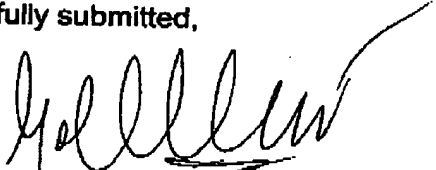
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Net: In view of the foregoing, it is Applicants' submission that the claims are patentably distinct over the prior art. Applicants therefore pray for their allowance or in the alternative request an Examiner's interview to discuss how the prosecution can be advanced in this case.

Respectfully submitted,

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